

### **REMARKS**

Applicant has studied the Office Action dated November 2, 2005. Claims 5-9, 16-20, 27-31 and 34 are pending. No amendments are included in this response. Reconsideration and allowance of the pending claims in view of the following remarks is respectfully requested.

#### **Rejection Under 35 U.S.C. § 102(e)**

The Examiner rejected claims 5-9, 16-20 and 27-31 under 35 U.S.C. § 102(e) as being anticipated by Serbinis et al (U.S. Patent No. 6,314,425) (hereinafter "Serbinis"). The Examiner cites 35 U.S.C. § 102(e) and a proper rejection requires that a single reference teach (i.e., identically describe) each and every element of the rejected claims as being anticipated by Serbinis.<sup>1</sup>

The Applicant traverses the Examiner's assertion that the Serbinis reference teaches the claimed limitations of:

determining that the nonce value is valid and has been accepted for fewer than the specified number of requests; and  
responding to the request by returning the data item in response to the determining that the nonce value is valid and accepted for fewer than the specified number of requests.

The Examiner states that "Serbinis et al, discloses 'If the number of retries exceeds the predetermined limit, the notification request flag is set to 'failed' at step 227, and the notification transaction is logged as 'failed,' at step 228.'" Office Action dated October 2, 2005, page 2, first paragraph (emphasis added, citing Serbinis, column 20, lines 16-25). The Examiner cites a portion of the Serbinis reference that discusses the retrying of notification transmissions upon failure of a notification transmission. (Serbinis, Col. 20,

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<sup>1</sup> See MPEP §2131 (Emphasis Added) "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim."

lines 16-25). The Applicant asserts that this portion of the Serbinis reference is not relevant to the processing, of even the Serbinis reference, related to controlling access to documents through use of tokens. The cited portion of Serbinis discusses sending "notifications," which are described as being sent in response to various user events, such as when a user registers for the service or when a new document is uploaded to the system. Serbinis, Col. 19, lines 33-43. The cited portion of Serbinis describes ensuring that the retries of these notifications do not exceed a predetermined limit. Serbinis, Col. 20, lines 16-25. The Applicant asserts that limiting the retransmissions of notifications, as taught by Serbinis, is not relevant to the subject matter of the presently claimed invention, which pertains to "controlling access to data on a computer" and more specifically limits the number of responses to requests for which a particular nonce value is used to be less than a specified number.

More specifically, the Applicant asserts that the tokens of the Serbinis reference are limited to having an expiration date and that any number of requests that present that token value prior to the expiration date for that token will be validated. The Serbinis reference has no teaching or suggestion of limiting the successful use of a nonce to only a specified number of requests. As set forth in the independent claims, the operation of the presently claimed invention does not restrict the time period in which the nonce can be used, only the number of times that the nonce can be used. The operation of the presently claimed invention provides flexibility in systems incorporating the nonce of the present invention since the user is free to use the nonce, and thereby receive the requested data, for the specified number of times over any time interval desired. This operation further provides additional functionality to the operator of the data server, since the number of data items provided to users is set, not simply the time span over which that data can be retrieved. In the system of Serbinis, a user is free to request a data item as often as the user desires prior to expiration of the token.

The Examiner further recites a portion of the MPEP that discusses the burden of proof for a rejection based on inherency and states that inherency is a question of fact. Office Action dated November 2, 2005, page 2, second paragraph. As further set forth in a related section of the MPEP:

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The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted) (The claims were drawn to a disposable diaper having three fastening elements. The reference disclosed two fastening elements that could perform the same function as the three fastening elements in the claims. The court construed the claims to require three separate elements and held that the reference did not disclose a separate third fastening element, either expressly or inherently.)

"In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original) (Applicant's invention was directed to a biaxially oriented, flexible dilation catheter balloon (a tube which expands upon inflation) used, for example, in clearing the blood vessels of heart patients). The examiner applied a U.S. patent to Schjeldahl which disclosed injection molding a tubular preform and then injecting air into the preform to expand it against a mold (blow molding). The reference did not directly state that the end product balloon was biaxially oriented. It did disclose that the balloon was "formed from a thin flexible inelastic, high tensile strength, biaxially oriented synthetic plastic material." *Id.* at 1462 (emphasis in original). The examiner argued that Schjeldahl's balloon was inherently biaxially oriented. The Board reversed on the basis that the examiner did not provide objective evidence or cogent technical reasoning to support the conclusion of inherency.).

MPEP §2112 (IV)

The Applicant respectfully asserts that the claimed limitation of "responding to the

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request by returning the data item in response to the determining that the nonce value is valid and accepted for fewer than the specified number of requests" clearly does not meet the above recited requirements for inherent disclosures. The Applicant respectfully asserts that this aspect of the present invention does not even fall within being "established by probabilities or possibilities" as prohibited by the above portion of the MPEP.

The Applicant respectfully points out that the above discussed teaching of Serbinis, which describes retrying notification transmissions from a server to a client, cannot be combined with the teachings of Serbinis regarding using tokens to limit access to a document to achieve the combination of elements recited by claims 5, 16 and 27, particularly when considering each of those claims "as a whole." Serbinis simply describes providing access to documents based upon a client providing a valid token. Serbinis column 21, line 52 through column 22, line 5. Serbinis never teaches or suggests limiting the use of a particular token to a specified number. The cited portion of Serbinis discusses resending notifications to a client that a document is ready so that the client can use a token to access the document. The Applicant asserts that these disparate functions of the Serbinis reference – controlling access to a document and notify a user of the availability of that document - cannot be combined to be a teaching of the presently claimed invention. The Applicant asserts that the presently claimed invention, particularly the element of "responding to the request by returning the data item in response to the determining that the nonce value is valid and accepted for fewer than the specified number of requests" is not "necessarily present in the thing described in the [Serbinis] reference" as is required by precedent and recited by the MPEP. See, MPEP §2112 (IV), citing *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). Further, the Applicant asserts that the Examiner has not provided "a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." MPEP §2112(IV), citing *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). As such, the Applicant respectfully asserts that the rejection of claims 5, 16 and 27 under 35 U.S.C. §102(e) is improper and should be withdrawn.

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The Applicant points out that claims 5, 16 and 27 are rejected as anticipated under 35 U.S.C. §102(e). The Applicant further asserts that even under an obviousness analysis under 35 U.S.C. §103, the prior art of record does not provide a motivation to combine the teachings of Serbinis related to controlling access to a document with the notification retransmission processing, as the Examiner is apparently asserting.

With regards to claims 9, 20 and 31, the Applicant traverses the Examiner's assertion that the Serbinis reference teaches that "the list of stored and valid nonce values is shared with an entity that originated the data request." Office Action dated November 2, 2005, page 4, fourth paragraph. The Examiner apparently is asserting that the "file sharing" of the Serbinis reference, which refers to the sharing of documents based upon presentation of a valid token, includes sharing the token list itself. The Applicant asserts that this is clearly not the case. The Applicant points out that the database discussed at column 21, lines 30-51, is examined to validate the received token values. There is no teaching, suggestion or motivation in the Serbinis reference, or in any of the other cited references, to share the database file in a manner similar to sharing documents. The teachings of the Serbinis reference are limited to storing and sharing documents or services provided by a common database and document store. Serbinis, Abstract; and column 10, lines 10-49. The documents to be shared are in the database, the data base files of Serbinis are not shared across a network. The Applicant respectfully refers to the requirements for inherent teachings discussed above. "The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. MPEP §2112(IV), citing *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" MPEP §2112(IV), citing *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). Further, the Applicant asserts that even under an obviousness analysis, there is no

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motivation provided by the prior art to share the database files as is apparently asserted by the Examiner.

Further, the cited portions of the Serbinis reference do not teach sharing tokens, but only generating and validating them. Serbinis, Abstract. Serbinis does teach proving tokens to users as part of a notification of an event. Serbinis, Col. 21, lines 27-29. Although individual tokens are shared by the Serbinis reference, the Serbinis reference does not teach or suggest sharing "the list of stored and valid nonce values" as is set forth in claims 9, 20, and 31. In the context of these claims, this "list of stored and valid nonce values" is defined in preceding claims from which these claims depend as the list to which the nonce value is compared to determine its validity. See, Claims 8, 19 and 31. The Applicant asserts that this "list of stored and valid nonce values" is clearly the entire list of currently stored and valid nonce values. The Applicant further asserts that Serbinis does not teach or suggest sharing this "list" with any entity, let alone the "entity that originated the data request".

Additionally, the Applicant notes that dependent claims 6-9, 17-20 and 28-31 depend from independent claims 5, 16, and 27, respectively. As discussed above, amended independent claims 5, 16 and 27 distinguish over the Serbinis reference. Since dependent claims include all of the limitations of the independent claims from which they depend, the Applicant further asserts that amended dependent claims 6-9, 17-20 and 28-31 also distinguish over the Serbinis reference as well. Therefore, the Applicant respectfully asserts that the Examiner's rejection under 35 U.S.C. §102(e) over Serbinis should be withdrawn.

#### Rejection Under 35 U.S.C. § 103(a)

The Examiner rejected claim 34 as being unpatentable over Serbinis in view of Khater, U. S. Patent Application Publication 2002/0184143 (Hereinafter "Khater") or Pisarsky U. S. Patent Application Publication 2002/0147838 (Hereinafter "Pisarsky"). Applicants point out that dependent claim 34 depends from independent claim 5 which, as discussed above, distinguishes over the Serbinis reference. Further, the Khater and Pisarsky references, taken either alone or in any combination with the Serbinis

reference, further fail to teach the claimed limitations of claim 5. Since dependent claims include all of the limitations of the independent claims from which they depend, the Applicant further asserts that dependent claim 34 also distinguishes over the cited references as well.

### **CONCLUSION**

Applicant respectfully submits that all of the grounds for rejection stated in the Examiner's Office Action have been overcome, and that all claims in the application are allowable. It is believed that the application is now in condition for allowance, which allowance is respectfully requested.

**PLEASE CALL** the undersigned if that would expedite the prosecution of this application.

Respectfully submitted,

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